



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,607	04/06/2001	Slobodan Vukicevic	STK/070	5821

1473 7590 02/12/2003

FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
50TH FLOOR  
NEW YORK, NY 10020-1105

EXAMINER

ROBINSON, HOPE A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/828,607</b>	Applicant(s) <b>Vukicevic et al.</b>
Examiner <b>HOPE ROBINSON</b>	Art Unit <b>1653</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Apr 6, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4)  Claim(s) 1-56 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 1-56 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6)  Other: \_\_\_\_\_

Serial Number 09/828,607  
Art Unit 1653

Restriction to one of the following inventions is required under  
35 U.S.C. 121:

5 I. Claims 1-34 are drawn to a method for repairing a defect locus in  
a nonarticular cartilage tissue of a mammal comprising differing  
osteogenic proteins such as OP-1, OP-2, OP-3 etc. and drawn to  
the sequences set forth in SEQ ID NOS: 3-7, from which an election  
of one sequence is required, classified in class 514, subclass 2.

10 II. Claims 35-46 are drawn to an implantable device comprising  
differing osteogenic proteins set forth in SEQ ID NOS: 3-7, from  
which an election of one sequence is required, classified in  
class 435, subclass 283.1.

15 III. Claims 47-50 are drawn to a method of promoting chondrogenesis,  
classified in class 514, subclass 21.

IV. Claims 51-56 are drawn to a method of repairing a defect locus in  
a ligament in a mammal, classified in class 514, subclass 2.

20 The inventions are distinct, each from the other because of the  
following reasons:

Groups I and II encompass several patentably distinct inventions as the  
claims consists of different osteogenic proteins, having different structure,  
thus different properties and function (see the sequence listing).

25 The inventions Groups I-IV are patentably distinct as the methods of  
Groups I, III and IV do not mention the use of the device of Group II, thus,  
can be used separately.

The methods of Groups I, III and IV are patentably distinct because the

Serial Number 09/828,607  
Art Unit 1653

methods have different method steps and end points. For example, the method of Group I is to affect cartilage whereas the method of Group IV is to affect ligament.

5        Furthermore, the inventions have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. A reference which would anticipate the invention of one group would not necessarily anticipate or make obvious the 10 other group. Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject 15 matter, election of a single group for examination purposes as indicated is proper.

20        A telephone call was made to Mr. James Haley on February 7, 2003 to request an oral election to the above requirement, but did not result in an election being made.

Applicant is advised that the response to this election requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

25        Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of

Serial Number 09/828,607  
Art Unit 1653

inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is 5 (703) 308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 5:30 P.M. (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be 10 directed to the Group Receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such 15 papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

20

*Christopher S. F. Low*  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Hope A. Robinson, MS  
Patent Examiner